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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/758,781

01/15/2004

Ali R. Rezai

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EXAMINER

LAYNO, CARL HERNANDZ

ART UNIT

PAPER NUMBER

3766

DATE MAILED: 07/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/758,781

Applicant(s)

REZAI, ALI R.

Examiner

Carl H. Layno

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3766

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Acknowledgment is made of applicant's amendment, which was received by the Office on May 22, 2006.

2. Claims 1-7 and 9-30 have been canceled. Claim 8 is active.

Specification

3. In view of the applicant's modifications to the specification, the Examiner is withdrawing the objections, which were made against the specification in the last Office action.

Claim Rejections - 35 USC § 112

4. In view of applicant's numerous claim cancellations, the Examiner is withdrawing the 35 U.S.C 112 rejections, which were made against claims 15 and 25-30 in the last Office action.

Double Patenting

5. In view of applicant's numerous claim cancellations, the Examiner is withdrawing the Double Patenting rejections, which were made against claims 1-7 and 11-30 in the last Office action.

Claim Rejections - 35 USC § 102

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6. Upon further reconsideration of applicant's numerous claim cancellations, the Examiner is withdrawing the 35 U.S.C 102(b) and 102(e) rejections of John (US 6,066,163 and US 6,463,328), respectively, which were made against claims 1-5, 9-11, 14-20, 23, 25, and 30 in the last Office action.

7. Upon further examination of these references, however, the Examiner has discovered that these references also read upon applicant's claim 8. Consequently, the Examiner is making the following new rejection based upon these previously cited references.

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

9. Claim 8 is rejected under 35 U.S.C. 102(b) as being anticipated by John (US 6,066,163).

The John (US 6,066,163) patent describes an adaptive deep brain stimulation method and system (Fig.1) whose operation appears to read upon applicant's claimed method steps. Specifically, John discloses that its implantable stimulation electrodes **50,78** (Fig.4) may be used to stimulate appropriate areas of the brain including, among other regions, the intralaminar nuclei (col.5, lines 33-35). Both scalp electrodes 12a and an implantable sensor electrode **82** (Fig.4) are used to sense physiological data of the brain (col.10, lines 43-46). Lacking specifics, the Examiner considers the position of electrode **82** to be "distal" from the stimulating device location in the intralaminar nuclei. The stimulation device delivers electrical therapy to the intralaminar nuclei to treat a variety of brain disorders including brain injury and coma (Abstract, line 3). *Applicant's attention is directed col.6, line 67 thru col.7, line 1, which states "Stimulation may also be continuous".*

10. Claim 8 is rejected under 35 U.S.C. 102(e) as being anticipated by John (US 6,463,328).

The John (US 6,463,328) patent describes a device which operates similarly to that of John '163, described above, in that it recites a deep brain stimulation (DBS) system (Fig.4) comprising stimulation electrodes **50,71,78** for stimulating the intralaminar nuclei (col.6, line 9), and sensing electrodes **12a** and **82** for obtaining physiological data from the brain (col.11, lines 51-54). Unlike John '163, this reference specifies alternative placements for sensing electrode **82** relative to stimulation electrode **50** – one of which may be considered "distal". See Figs.4 and 7. The stimulation system of John '328 is used to treat disorders such as traumatic brain injury, coma, movement disorder (Abstract, lines 1-3), tremor (col.16, lines 45-64), or addiction

(paragraphs [0022-0023]). *Applicant's attention is directed to col. 7, lines 59-60, which states that "Stimulation may also be continuous".*

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

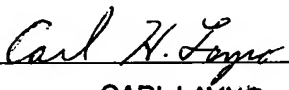
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carl H. Layno whose telephone number is (571) 272-4949. The examiner can normally be reached on 9/4/5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert E. Pezzuto can be reached on (571) 272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



CARL LAYNO
PRIMARY EXAMINER

CHL
7/17/2006